

### REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-7, 10 and 11 are rejected under 35 USC 102(b) over the U.S. patent to Grover.

Claims 8, 9 and 12 are rejected under 35 USC 103(a) over the U.S. patent to Grover in view of the U.S. patent to Shimasaki.

Claims 13 and 14 are rejected under 35 USC 103(a) over the U.S. patent to Grover.

Also, the title of the invention, the Abstract of the Disclosure and the claims are objected to.

After carefully considering the Examiner's grounds for the objections, applicants provided a new title of the disclosure, introduced a new Abstract of the Disclosure, and amended the claims.

It is believed that the Examiner's grounds for the formal objections are therefore eliminated.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants cancelled Claims 4 and 6 and introduced their features into Claim 1.

It is respectfully submitted that Claim 1 as amended now defines that the flexible tip is formed by segments (4') which are inserted into one another, so that in a curved condition of the tip shown in Figure 1b is formed, and the curved tip is arrestable in the curved condition.

The U.S. patent to Grover discloses a measuring device with a tubular tip (12), in which the measuring sensor (18) is integrated. The tubular tip (12) which carries the measuring sensor (18) is connected via a cable (40) with its connection end (46). In the patent to Grover, however, the tubular tip (12) is not formed flexible, but instead covers only the cable (40) which is coated with a flexible tube (45) as explained in column 3, lines 53-57.

The Examiner indicated that the coated flexible tube (45) which surrounds the cable (4) and the tip (12) form segments which are inserted into one another in the sense of the present invention. This argument however is not justified, since the flexible tube (45) and the element (12) are different components and the tubular element (12) is not a part of the flexible tube (45).

The patent to Grover also does not disclose the features of original Claim 6, in accordance with which the tubular segments (4') are lockable in a bent state. The Examiner's opinion that in the Grover reference the tip is lockable in a position in a bent state is wrong. In the Grover reference not the flexible tube (45) is locked relative to the tubular element (12) identified as a further segment, but instead the tubular element (12) is locked in a separate mounting element (20) which is placed on a special machine part (22). The locking of the tubular element (12) on the separate mounting element (20) in accordance with the teaching of the Grover reference has nothing to do with a locking of the individual segments (4') over one another in accordance with the present invention.

It is believed that Claim 1 as amended should be considered as patentably distinguishing over the Grover reference.

The other claims were rejected over this reference as being anticipated. In connection with this, it is believed to be advisable to cite the decision *In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Grover does not disclose each and every element of the present invention as now defined in amended Claim 1. Therefore, the anticipation rejection of the original claims should be considered as no longer tenable with respect to amended Claim 1 and should be withdrawn.

As for the Examiner's grounds for the obviousness rejections applied against the original claims, it is respectfully submitted that the references do not contain any hint, suggestion, or motivation for the new features of the present invention which are now defined in amended Claim 1.

In order to arrive at the applicant's invention as defined in Claim 1 from the teachings of the references, the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in amended Claim 1 and which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is believed that the features of this claim should be considered as not tenable with respect to amended Claim 1 and should be withdrawn.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

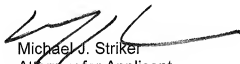
As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicant  
Reg. No. 27,233  
103 East Neck Road  
Huntington, New York 11743  
631 549 4700